

Application No. 10/800,492
Filed: March 15, 2004
TC Art Unit: 1751
Confirmation No.: 9279

REMARKS

Pending claims 1-26 have been finally rejected as obvious over Marquis et al. This rejection is respectfully traversed in light of the amendments and arguments given below and reconsideration is requested.

The Applicant's undersigned attorney is appreciative of the opportunity for a telephone interview with the Examiner on January 30, 2006. The rejection over Marquis et al. was discussed, and the Examiner explained his interpretation of col. 2, lines 6-7. The claimed pH range of the compositions according to the invention have been modified in response to the Examiner's concern.

Applicant's claim amendments, however, are not to be construed as an admission that the Examiner's rejections were proper. The Applicant continues to believe that the rejected claims are described in and enabled by the specification, and are not obvious in view of the cited references, as previously argued. The rejected claims have been amended for the sole purpose of advancing the case to allowance. The Applicant reserves the right to file a continuing application to continue the prosecution of the rejected claims.

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It is the Examiner's position that Marquis et al. at col. 2, lines 6-7, where it is stated that the disclosed composition has a "neutral pH (or slightly acidic or slightly basic pH)," teaches directly or makes obvious Applicant's claimed pH range. Applicant submits that the claims as amended are not obvious over Marquis et al.

As the Applicant has stated before, Marquis et al. emphasizes that an important attribute of the disclosed composition is a neutral pH. Yes, Marquis et al. does state, within parentheses, "(or slightly acidic or slightly basic pH)." However, as the Examiner well knows, the pH scale is an arbitrary human concoction. Any chemistry book will say something like, "The dissociation constant K_w , the ion product of water, is approximately 10^{-14} at 25° C" (emphasis added). For ease of calculation, then, the pH scale was arbitrarily established to have a range of 14, with "neutrality" at 7. In real life, however, things are not so simple. A so-called "neutral" solution can "stray" from pH=7. Therefore, to reflect what is actually happening, researchers will state that a solution with a pH in the range of, for example, 6.8-7.2 is a "neutral solution" or they will take the approach of Marquis et al. and include pH's that are "slightly acidic or slightly basic" within their concept of

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neutrality. In contrast, the Applicant wants a truly acid pH and requires that the claimed composition as amended maintain a pH of between 2 and 6. Furthermore, the Applicant stresses the advantages of maintaining the compositions of the invention at an acid pH while Marquis et al. stresses the advantages of a neutral pH. Thus, the Applicant's choice of pH is derived from the insight that led to his invention and is not "mere optimization" as the Examiner indicated.

Furthermore, at the cited place, Marquis et al. makes no reference at all to buffering the disclosed composition. In contrast, claim 1 of the instant application requires "an effective amount of a pH-buffering agent that is chemically inert in said composition and that maintains the pH of said composition between approximately pH 2 and pH 6.0." The Examiner's statement that it would be obvious to modify the composition of Marquis et al. to obtain Applicant's invention would be contrary to the teachings of that reference. It is settled law that a reference may not be applied in a manner that runs counter to its teachings.

The Examiner also states that one skilled in the art "would have been able to modify" the composition of Marquis et al. With respect, Applicant points out that being "able to modify" a reference is not the standard. The suggestion to modify the

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reference must come from the reference itself. Otherwise, an Examiner is using impermissible hindsight to reconstruct the Applicant's claims based on the teachings in the *Applicant's* specification.

Finally, the Examiner justified his modification of Marquis et al. by stating that an acidic composition would "further increase the effectiveness of said paint removing compositions." Besides the fact that there is no suggestion at all in Marquis et al. of such an effect of acidifying the disclosed compositions, the Applicant submits with respect that acidification within the range recited in the instant claims would not even have the effect proposed by the Examiner in that *acid-based* stripping is known to require a lower pH than that recited in the Applicant's claims.

Thus, Applicant submits that the rejection has been overcome and all claims are in condition for allowance. Such action is respectfully requested.

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The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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